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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,846	07/30/2003	James Thomas Edward McDonnell	1509-431	6136

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EXAMINER

BALAOING, ARIEL A

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/629,846

Applicant(s)

MCDONNELL ET AL.

Examiner

Ariel Balaoing

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☒ Claim(s) 32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/30/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Objections*

1. Claim 32 is objected to because of the following informalities: on line 3 of claim 32 the limitation "providing details of the location of *the* or each access node".

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 11-16, 18, 19, 27-30, 32 are rejected under 35 U.S.C. 102(e) as being anticipated by GUNNARSSON et al (US 2003/0118015).

Regarding claim 1, GUNNARSSON discloses a communication system comprising notification means arranged to locate a mobile unit and to transmit a notification to said mobile unit (60-Figure 1-3) via a first telecommunication network (10-Figure 1-3) when said mobile unit moves within the vicinity of an access node of a second network [WLAN] (20-Figure 1-3) (abstract; paragraph 5, 18).

Regarding claim 2, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. GUNNARSSON further discloses wherein said notification comprises a voice message or text message (paragraph 22).

Regarding claim 11, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. GUNNARSSON further discloses wherein said mobile unit is capable of communicating with both said first and said second networks, said mobile unit being capable of communicating with said second network only when within a predetermined range of said access node (paragraph 24, 28).

Regarding claim 12, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. GUNNARSSON further discloses further comprising a further mobile unit [wireless computing device] (70-Figure 2, 3) for communication with said second network, said further mobile unit being capable of communication with said second network only when within a predetermined range of said access node (paragraph 18, 28).

Regarding claim 13, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. GUNNARSSON further discloses wherein the rate of communication with said second network is at a higher data rate than the rate of communication with said first network (paragraphs 14, 17; WLAN is preferred for high-bandwidth data transfers. It is also known the art that local area networks in general have higher data transfer rates then mobile communication networks).

Regarding claim 14, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. GUNNARSSON further discloses wherein the location of the access node is held on a storage medium [database] in communication with said first network (paragraph 22).

Regarding claim 15, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. GUNNARSSON further discloses wherein said first network comprises a cellular communication system (abstract; paragraph 12, 20).

Regarding claim 16, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. GUNNARSSON further discloses wherein said second network comprises a wireless LAN or a 3G pico-cell (abstract; paragraph 14, 16).

Regarding claim 18, GUNNARSSON further discloses a method of notifying a mobile device user to the presence of a network access node (abstract), the method comprising: providing a first network in communication with said mobile device (10-Figures 1-3); determining the location of said mobile device (paragraph 18); and transmitting a notification from said first network to said mobile device when said mobile device moves within the vicinity of a network access node of a second network (paragraph 18, 28).

Regarding claim 19, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. GUNNARSSON further discloses wherein said notification comprises a voice message or text message (paragraph 22).

Regarding claim 27, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. GUNNARSSON further discloses wherein the location of said at least one network external access node is held in a storage medium, said storage medium being in communication with said first network (paragraph 22).

Regarding claim 28, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. GUNNARSSON further discloses wherein communication with said second network is achieved using said mobile device when said mobile device is within a predetermined range of said external access node (paragraph 24).

Regarding claim 29, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. GUNNARSSON further discloses wherein communication with said second network is achieved using a further mobile device when said further mobile device is within a predetermined range of said external access node (paragraph 18, 28).

Regarding claim 30, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. GUNNARSSON further discloses wherein communication with said second network occurs at a greater data rate than communication with said first network (paragraphs 14, 17; WLAN is preferred for high-bandwidth data transfers. It is also known the art that local area networks in general have higher data transfer rates then mobile communication networks).

Regarding claim 32, GUNNARSSON discloses A method of operating a wireless communication system, the wireless communication system comprising one or more access nodes to the wireless communication system, the method comprising providing details of the location or each access node to a further telecommunications network (abstract, paragraphs 22, 23, 28).

***Claim Rejections - 35 USC § 103***

Art Unit: 2683

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 3-5, 20, 21 rejected under 35 U.S.C. 103(a) as being unpatentable over GUNNARSSON et al (US 2003/0118015) in view of JUURIKKO (US 2003/0003868 A1).

Regarding claims 3 and 20, see the rejections of the parent claims concerning the subject matter these claims are dependant upon. However, GUNNARSSON does not disclose wherein said notification contains the location of said access node.

JUURIKKO discloses wherein said notification contains the location of said access node (paragraph 23). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the paging of GUNNARSSON to include locations and directions to the wireless access points as both disclosures deal with sending notification to a mobile device in regards to locating an access point. This is beneficial in that it allows the invention of GUNNARSSON the ability to quickly move

towards the access point to achieve greater signal strength and network reliability with the WLAN.

Regarding claim 4, see the rejections of the parent claims concerning the subject matter these claims are dependant upon. GUNNARSSON further discloses wherein the notification further comprises one or more from the list including the data transfer rate supported by the access node, details of the transmission coverage provided by the access node, the cost to a user of utilizing the access node and details of goods and services available at the access node (paragraph 22).

Regarding claims 5 and 21, see the rejections of the parent claims concerning the subject matter these claims are dependant upon. However, GUNNARSSON does not disclose wherein said notification contains directions to said access node. JUURIKKO discloses wherein said notification contains directions to said access node (paragraph 23). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the paging of GUNNARSSON to include locations and directions to the wireless access points as both disclosures deal with sending notification to a mobile device in regards to locating an access point. This is beneficial in that it allows the invention of GUNNARSSON the ability to quickly move towards the access point to achieve greater signal strength and network reliability with the WLAN.

7. Claims 6-8, 10, 17, 22-24, 26, 31 rejected under 35 U.S.C. 103(a) as being unpatentable over GUNNARSSON et al (US 2003/0118015) in view of JOKINEN et al (US 2002/0095333 A1).



Regarding claims 6 and 22, see the rejections of the parent claims concerning the subject matter these claims are dependant upon. However, GUNNARSSON does not disclose wherein said notification comprises an electronic token. JOKINEN discloses wherein said notification comprises an electronic token [e-coupon] (paragraphs 38, 55, 57). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify GUNNARSSON to transmit a redeemable coupon to a mobile device during notification of WLAN service as JOKINEN and GUNNARSSON disclose the transmittal of information regarding services at an access point between a wireless local area network and a mobile device. This is beneficial in that it allows the system of GUNNARSSON the ability to advertise discounted services or goods at a retail outlet.

Regarding claims 7 and 23, see the rejections of the parent claims concerning the subject matter these claims are dependant upon. However, GUNNARSSON does not disclose wherein said electronic token has a redeemable monetary value. JOKINEN discloses wherein said electronic token has a redeemable monetary value (paragraph 38, 55, 57; the coupon is redeemable for a discounted amount on goods and services).

Regarding claims 8 and 24, see the rejections of the parent claims concerning the subject matter these claims are dependant upon. Although GUNNARSSON discloses that the access point can be placed at retail outlets (paragraph 15), GUNNARSSON does not disclose wherein said access node is located at a retail outlet at which said electronic token is redeemable. JOKINEN discloses wherein said access

node is located at a retail outlet at which said electronic token is redeemable (paragraph 57).

Regarding claims 10 and 26, see the rejections of the parent claims concerning the subject matter these claims are dependant upon. However, GUNNARSSON does not disclose wherein said electronic token is transmitted only when said mobile unit is in communication with said second network. JOKINEN discloses wherein said electronic token is transmitted only when said mobile unit is in communication with said second network (paragraph 38).

Regarding claim 17, GUNNARSSON discloses a telecommunication system comprising: at least one base station (14-Figure 1) for communication with at least one mobile communication device via a first wireless telecommunication network (paragraph 12); means for determining the location of the mobile communication unit (paragraph 18); means for accessing a data storage device having the location of at least one access point of a second wireless telecommunication network stored thereon (paragraph 22); and means for causing a notification to be transmitted to the mobile communication device first comes within a predetermined distance of the access point of the second wireless telecommunication network (paragraphs 18, 22, 28). However GUNNARSSON does not discloses wherein the notification comprising an electronic token redeemable at the location of the access point. JOKINEN discloses wherein the notification comprising an electronic token redeemable [e-coupon] (paragraphs 38, 55, 57) at the location of the access point. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify

GUNNARSSON to transmit a redeemable coupon to a mobile device during notification of WLAN service as JOKINEN and GUNNARSSON disclose the transmittal of information regarding services at an access point between a wireless local area network and a mobile device. This is beneficial in that it allows the system of GUNNARSSON the ability to advertise discounted services or goods at a retail outlet.

Regarding claim 31, GUNNARSSON discloses A method of notifying a mobile communication device user to the presence of a network access point (abstract, paragraph 18), the method comprising transmitting a notification to a mobile communication device via a first telecommunication network when that mobile communication device first moves within a predetermined distance of a network access point (paragraphs 18, 22, 28). However GUNNARSSON does not disclose wherein the notification comprises a reward redeemable at a retail outlet located at the network point. JOKINEN discloses wherein the notification comprises a reward redeemable at a retail outlet located at the network point (paragraphs 38, 55, 57). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify GUNNARSSON to transmit a redeemable coupon to a mobile device during notification of WLAN service as JOKINEN and GUNNARSSON disclose the transmittal of information regarding services at an access point between a wireless local area network and a mobile device. This is beneficial in that it allows the system of GUNNARSSON the ability to advertise discounted services or goods at a retail outlet.

8. Claims 9 and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over GUNNARSSON et al (US 2003/0118015) in view of JOKINEN et al (US 2002/0095333

A1) as applied to the parent claims above, and further in view of KAMINKOW et al (US 2003/0036425 A1).

Regarding claims 9 and 25, see the rejections of the parent claims concerning the subject matter these claims are dependant upon. However, the combination of GUNNARSSON and JOKINEN does not disclose wherein said electronic token comprises a gaming credit. KAMINKOW discloses wherein said electronic token comprises a gaming credit (paragraphs 64, 197, 198). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of GUNNARSSON and JOKINEN to include the transmission of gaming credits during the notification of a WLAN as the systems disclose a method for transmitting coupons for location dependant services. This is beneficial in that it allows the combination of GUNNARSSON and JOKINEN the ability to lure customers to a gaming establishment using the notification of a WLAN in the vicinity.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

KNUTSSON et al (US 2002/0006788 A1) – Location based information and services

BEN-YEHEZKEL et al (US 6,049,711) – Location based information services

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ariel Balaoing whose telephone number is (571) 272-

7317. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 AM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571) 272-7872. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ariel Balaoing  
Patent Examiner  
Art Unit 2683

AB



JOSEPH MANCU  
PATENT EXAMINER